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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
07/728,428	07/11/1991	JO ANN M. CANICH	89B010-D-1	5216
23455 7590 09/24/2007 EXXONMOBIL CHEMICAL COMPANY 5200 BAYWAY DRIVE P.O. BOX 2149 BAYTOWN, TX 77522-2149			EXAMINER RABAGO, ROBERTO	
			ART UNIT 1713	PAPER NUMBER
			MAIL DATE 09/24/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

07/728,428

Applicant(s)

CANICH, JO ANN M.

Examiner

Roberto Rábago

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27, 44-52, 54-56, 60-74 and 77-134 is/are pending in the application.
- 4a) Of the above claim(s) 83-121 and 127-132 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27, 44-47 and 122 is/are allowed.
- 6) ☒ Claim(s) 48-52, 54-56, 60, 61, 63-74, 77-82, 123, 125, 126 and 133 is/are rejected.
- 7) ☒ Claim(s) 62, 124 and 134 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of group I, claims 27, 44-56, 60-82 and 122 in the reply filed on 6/25/2007 is acknowledged. The traversal is on the ground(s) that there is no burden. This is not found persuasive for the reasons set forth in the Advisory action mailed 5/16/2007. As stated previously, the addition of new claims to a second class of invention would involve substantial examination burden, particularly in an application such as this one, which has a long and complex history of interference proceedings and double patenting relationships. The search required for a process of polymerization is not required in a search for a chemical structure, and therefore the new consideration of additional, potentially unlimited number of new process claims would necessarily involve search burden. The requirement for restriction is proper and is therefore made FINAL.

New claims 123-126, 133 and 134 are joined with group I. New claims 127-132 are joined with group II and withdrawn from consideration.

### ***Double Patenting***

2. Claims 48-52, 54-56, 60, 61, 63-74, 77-82, 123, 125, 126 and 133 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 5 of U.S. Patent No. 7,041,841. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons set forth in:

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item 9 of the Office action mailed 9/14/2006, item 2 of the Office action mailed 2/23/2007, and item 3 of the Office action mailed 5/16/2007.

Assuming a two-way test is required, Applicants argue that the patented claims 1-3 and 5 are not obvious over the instant claims because of "the special combination of Hf or Zr with x being 2 or 4" and cite col. 25, line 29. The patented specification has been reviewed, but no special relationship can be discerned, and applicants have not pointed to any particular evidence of unexpected results. However, the concept of unexpected results may be moot because the patented claims are not only obvious, but are anticipated by the instant claims. Specifically, instant claim 56 recites that the Cp ligand may be either fluorenyl or octahydrofluorenyl; such species are symmetrically substituted with x=4, and therefore would anticipate the feature of x=4. The remaining limitations set forth in the patented claims are so closely coextensive with those of instant claim 48 that anticipation of the patented claims is established.

***Claim Rejections - 35 USC § 112***

3. Claim 125 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 125 is indefinite because it is broader than the parent claim.

***Allowable Subject Matter***

4. Claims 27, 44-47 and 122 are allowed.

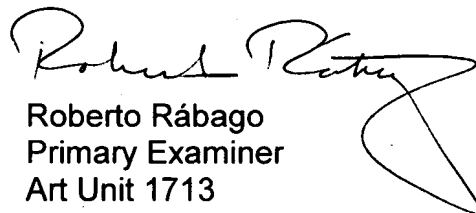
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5. Claims 62, 124 and 134 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Roberto Rábago  
Primary Examiner  
Art Unit 1713

RR  
September 15, 2007